

JUN 21 2007

Application No.: 10/516,556

Art Unit: 3641

Docket No.: FHW-136US

**REMARKS**

Applicant amends claims 1 and 14. Claims 1-17 are pending, of which claim 1 is independent. No new matter has been introduced. Support for the amendments to independent claim 1 can be found in Figure 1 of the instant application. Applicant respectfully submits that the pending claims define over the art of record.

**The Claimed Invention**

The claimed invention is generally directed to a marker projectile. The marker projectile has a hollow body with an opening at the front. A marker substance is disposed within the hollow body, and an expelling member is disposed within the hollow body behind the marker substance. A portion of the hollow body separates the expelling member from the axial bore of the projectile. The hollow body and the expelling member are configured such that upon impact of the projectile with a target, the momentum of the expelling member relative to the hollow body carries the expelling member forwardly to expel the marking substance through the opening. A separator extends at least partly over the front of the opening, the separator defining two or more spaces through which the marker substance may pass when expelled through the opening.

In the claimed invention, the motivating force urging the expelling member forwardly against the marking substance is the expelling member's own momentum. There is no need for a piston/cylinder arrangement driven by the expanding propellant gases within the gun barrel upon firing.

**Rejection of Claims 1-17 under 35 U.S.C. §112**

Claims 1-17 are rejected under 35 U.S.C. §112, first paragraph, because the specification allegedly does not provide enablement for an expelling member that is not a ball bearing. See Office Action, page 2, paragraph 2. Claims 1-17 are also rejected under 35 U.S.C. §112, second paragraph, as allegedly being incomplete for omitting a ball bearing. See Office Action, pages 2-3, paragraph 6. Applicant respectfully disagrees with the Examiner's allegations for at least the following reasons.

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Figure 1 of the instant application depicts a ball bearing only as one embodiment of an expelling member. The Specification discusses at page 6, lines 1-4 that the expelling member can take a variety of shapes provided that it is rotationally symmetrical about its longitudinal axis. Thus, the Specification provides enablement for an expelling member that may not be a ball bearing. Additionally, it would be obvious to one of ordinary skill in the art that an expelling member of a form other than a ball bearing could be accommodated within the hollow body of the projectile and used according to the claimed invention. As such, Applicant believes that the claims need not be restricted to the single embodiment depicted in Figure 1. Applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. §112, first and second paragraph, rejections of claims 1-17.

**Rejection of Claims 1-8, 10 and 12 under 35 U.S.C. §102**

Claims 1-8, 10 and 12 are rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent Number 5,654,524 to Saxby (hereafter "Saxby"). See Office Action, page 3, paragraph 2. Applicant respectfully submits that the Saxby reference fails to disclose at least the following feature of amended independent claim 1: "a portion of the hollow body separating the expelling member from an axial bore of the projectile."

The Saxby reference teaches a projectile with a hollow casing and a perforated nose portion. A piston is disposed within the casing, and a marking substance is disposed forwardly of the piston. The piston is movable forwardly under force applied to it by gas used to discharge the projectile. The marking substance is thereby compressed and expelled through the nose portion for contact with a target. See Saxby, abstract.

Applicant respectfully submits that the Saxby reference does not disclose "a portion of the hollow body separating the expelling member from an axial bore of the projectile," as recited in amended claim 1. As illustrated in Figure 1 of Saxby, the piston 3 is directly in contact with the axial bore 7 of the bullet. This construction is relied upon in the Saxby apparatus to expel the dye through slots in the nose of the bullet. The Saxby reference teaches that upon firing, the gas serving to propel the bullet from the barrel of a weapon penetrates through the bore 7 and drives the piston 3 forward to nest within the nose 11. The piston thereby expels the dye through the slots 5. See Saxby, column 1, lines 59-65. The Saxby reference does not disclose that a

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portion of the hollow body of the projectile separates the expelling member from the axial bore of the projectile, as required by amended claim 1.

In view of the foregoing claim amendments and arguments, Applicant respectfully submits that the Saxby reference fails to disclose each and every feature of amended independent claim 1. As such, Applicant respectfully submits that amended claim 1 defines over the art of record. Applicant respectfully requests reconsideration and withdrawal of the U.S.C. §102(b) rejection of claim 1.

Claims 2-17 depend upon claim 1, and add separate and patentable limitations to claim 1. As such, for this and the reasons set forth above, Applicant respectfully submits that the dependent claims also define over the art of record.

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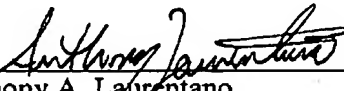
**CONCLUSION**

In view of the foregoing amendments and arguments, Applicant believes the pending application is in condition for allowance.

Applicant believes that no fee is due with this statement. However, if a fee is due, please charge our Deposit Account No. 12-0080, under Order No. FHW-136US from which the undersigned is authorized to draw.

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Respectfully submitted,

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